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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,554	08/07/2001	James William Otter	60246-145/8674	6915

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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/05/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,554

Applicant(s)

OTTER, JAMES WILLIAM

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: in line 2, the first occurrence of the term "and" should be deleted. Appropriate correction is required.
2. Claim 11 is objected to because of the following informalities: in line 2, the term "cross-links" should be "cross-link". Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentley (USPN 4,738,307) in view of Audett et al (USPN 5,331,049) or Prejean et al. Bentley teaches a heat condensing heat exchanger and a method of making said heat exchanger wherein a polypropylene film is adhesively adhered to a metal surface (Abstract.) Bentley does not specifically teach the type of adhesive utilized or that the adhesive is an ethylene terpolymer having an organosilicone functional group that is cured by water as instantly claimed. However, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any suitable adhesive having metal adhesion and heat resistance or other desired properties for use in a heat exchanger wherein Audett et al and Prejean et al both teach that the water-curable ethylene terpolymer hot melt adhesive comprising an organosilicone functional group as instantly claimed provides advantageous over other hot melt adhesives including curing

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at ambient temperatures with moisture or water and also provides excellent heat resistance and enhanced adhesive strength to metallic substrates when coated onto the substrate (Audett et al-Abstract, Col. 1-Col. 2, line 52; Prejean-Abstract, Col. 1.) Therefore, one having ordinary skill in the art at the time of the invention would have been motivated to utilize the water-curable ethylene terpolymer taught by Audett et al or Prejean et al for the invention taught by Bentley wherein roll coating is an obvious and conventional method of applying an adhesive to a substrate and would have been obvious to one skilled in the art. Further, in terms of providing moisture or water to cure the adhesive, it would have been obvious to one skilled in the art at the time of the invention to determine the optimum method of providing the moisture or water to the adhesive, whether externally or internally within the structure to be bonded, to provide the desired amount of water to cure the adhesive. With respect to Claim 8, though Bentley does not teach that the polypropylene film is polar, it is well known and conventional in the art to subject a polypropylene film to a surface treatment such as corona discharge treatment to provide polar groups on the film surface to enhance adhesion of the film to a subsequently applied adhesive or coating and hence one having ordinary skill in the art at the time of the invention would have been motivated to subject the polypropylene film to an appropriate surface treatment such as corona discharge treatment to provide adhesion-enhancing polar groups on the film surface.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 9-10 of U.S. Patent No. 6,527,906 in view of Audett et al or Prejean et al. Though the conflicting claims are not identical, they are not patentably distinct because both recite a polypropylene film adhered to a metal condensing heat exchanger component and a method for adhering said film to said metal via a water-curable organosilicone functional polymer. Though Patent '906 claims a silicone elastomer adhesive with the organosilicone functional groups while the instant application claims an ethylene terpolymer adhesive with organosilicone functional groups, one having ordinary skill in the art at the time of the invention would have recognized the ethylene terpolymer adhesive with organosilicone functional groups as a species of silicone elastomer and further Audett et al and Prejean et al both teach that the water-curable ethylene terpolymer hot melt adhesive comprising an organosilicone functional group as instantly claimed provides advantageous over other hot melt adhesives including curing at ambient temperatures with moisture or water and also provides excellent heat resistance and enhanced adhesive strength to metallic substrates when coated onto the substrate. Further, in terms of providing moisture or water to cure the adhesive, it would have been obvious to one skilled in the art at the time of the invention to determine the optimum method of providing the moisture or water to the adhesive, whether externally or internally within the structure to be bonded, to provide the desired amount of water to cure the

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adhesive. With respect to Claim 8, though Patent '906 does not claim that the polypropylene film is polar, it is well known and conventional in the art to subject a polypropylene film to a surface treatment such as corona discharge treatment to provide polar groups on the film surface to enhance adhesion of the film to a subsequently applied adhesive or coating and hence one having ordinary skill in the art at the time of the invention would have been motivated to subject the polypropylene film to an appropriate surface treatment such as corona discharge treatment to provide adhesion-enhancing polar groups on the film surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson
Patent Examiner
Technology Center 1700
June 2, 2003